APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,694	07/19/2001	Yushi Ihara	450101-02708	9558

20999	7590	11/02/2005

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EXAMINER
DIVINE, LUCAS

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/831,694	IHARA, YUSHI
	Examiner	Art Unit	
	Lucas Divine	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 July 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *3 and 6* is/are allowed.

6)☒ Claim(s) *1,2,4,5 and 7-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☒ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Claims 1 – 10 are pending.

2.   Previous § 112 rejections withdrawn due to amendments.

Response to Arguments

3.   Applicant's arguments filed 7/19/05 have been fully considered but they are not

persuasive.

With respect to applicant's arguments on page 12 that neither of the references teach the

new limitation.

In reply, Mori teaches printing a print sheet in a position of associated block information

(e.g. Fig. 10, wherein a blank image is printed in the position of block SP14) not present in a

desired result (the block information, whatever internal code designating the block [e.g.

parameters, positions, for printing discussed in col. 8 lines 60-64], is not printed in the desired

result shown in Fig. 10). Therefore, Mori does teach the new limitation and the rejection is

maintained.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claims 1, 2, 4, 5, and 7 – 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has indicated in remarks and telephone interview dated 10/27/05 that pages 56-57 and figures 45-47 teach the new amendment ideas of claims 1, 2, 4, 5, and 7 – 10.

- Fig. 45 is described as a common result (page 56, paragraph starting with 'For example,').

- Fig. 46 is described as a result when an album doesn't have a title list (page 56, paragraph starting with 'However,').

- Fig. 47 is described as a result when a blank area is printed in the place of the missing title list (bottom page 56 – top page 57).

None of these are described as a 'desired result' and thus any of them could be.

A reading suggests that Fig. 47 allows the 'moving forward' of Fig. 46 to be avoided, and thus possibly may be the desired result. But if Fig. 47 is the desired result, the position of block information that includes the blank image (lower left) is present in the desired result. Further, the top paragraph on page 47 talks about the printer receiving the capture command (having the control information) and printing the image in the corresponding place. Thus, the capture command would include control information to print the blank image in the lower left and the position would be in a desired result.

Further, there is no block information discussion on these pages to further give light to what a position of associated block information may be.

After also reviewing the rest of the specification, Examiner has determined that there is inadequate support for the amendments to claims, 1, 2, 4, 5, and 7 – 10 in the original disclosure and thus the amendments introduce new matter.

5.   Claims 1, 2, 4, 5, and 7 – 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not enable one skilled in the art to develop control information that includes printing a blank image on a print sheet in a position of block information that not present in a desired result. It does enable one skilled in the art to print blank areas on a print sheet (see bottom of 56 and top of 57 – 'sets a capture command as shown in Fig. 48 in accordance with the operation input from the user... the printer device 5 having received the capture command thus set, makes a blank in the corresponding area on the basis of the setting'. This shows enabling disclosure for generating control information including the printing of a blank image in an area of the page that has been set (thus is desired). No enabling disclosure has been found for printing a blank image in a not desired area.

6.   Claims 1, 2, 4, 5, and 7 – 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims include the language 'in a position of associated block information that is not present in a desired result'. It is unclear and indefinite what the

pronoun 'that' describes. Is the blank image not present in a desired result? Is the block

information not present in a desired result? Is the position of the block image not present in a

desired result?

Examiner's note: Applicant indicated in interview dated 10/27/05 that future amendments

would include the elimination of the phrase 'that is' from the claims, and thus in the art

rejections below the claims will be interpreted in this way.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   Claims 1, 2, 4, 5, and 7 – 10 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Mori (US 6411400) in view of Fukunaga et al. (US 6603737) hereafter referred to as Mori

and Fukunaga.

Regarding claim 1, Mori teaches **an image processing device** (host computer 300 as

shown functionally in Figs. 2 and 3) **comprising:**

image processing means (CPU 1; col. 4 lines 51-53) **for performing image processing**

on an image signal inputted from outside (image data can be inputted from external memory

11 for print preparation) **and generating image data** (graphic engine 202 as shown in Fig. 3 is

controlled by the CPU and takes an image signal and rasterizes it into image data for printing and

then sends the data to the printer driver 203; col. 4 line 54 and col. 6 lines 42-44);

control information generation means (printer driver 203; col. 6 lines 25-27) **for**

generating control information (control commands for the printer discussed in col. 6 lines 48-

51) **including information indicating the number of print images on one page of a print**

sheet (F11 in Fig. 9 shows a clear example of information indicating the number of print images

on one page; col. 9 lines 38-52, wherein N is the number of print images on one page); **and**

output means (system spooler 204 as shown in Fig. 3 outputs image data and control

information to the printer for controlling the printing of the printer, wherein the actual physical

device sending the data over the interface 21 is the printer controller 8) **for including the image**

data generated by the image processing means and the print control information generated

by the control information generation means and outputting to a printing device (outputting

data to the printer; col. 1 lines 55-56);

the control information generation means generating print control information

including information which includes a blank image in the image to be printed on the print

sheet (Fig. 8 step 3, Fig. 10 spaces SP11, SP12, SP13, SP14, Fig. 11, Fig. 13; col. 1 lines 56-57

and throughout – in the invention of Mori, a user can select to include blank pages along with

image pages in order to allow for notes to be taken, this blank page can be completely blank or

have blank spaces in it as shown in Fig. 11, this blank page information then must be sent along

with the rest of the print job to be printed on the sheet [examples shown in Fig. 10 and 12]) **in a**

position of associated block information (e.g. Fig. 10, wherein a blank image is printed in the

position of block SP14) **not present in a desired result** (the block information, whatever

internal code designating the block [e.g. parameters, positions, for printing discussed in col. 8

lines 60-64], is not printed in the desired result shown in Fig. 10).

While Mori teaches the sending of data to and from a printer in Fig. 2 through a predetermined communication medium [col. 1 line 12] bi-directional [col. 5 line 17] interface 21, Mori does not specifically teach that this interface be **the IEEE (the Institute of Electrical and Electronics Engineers) 1394 standard which utilizes packets for sending data.**

Fukunaga teaches interfacing between a computer and a printer via **the IEEE 1394 standard** (Fig. 1A; col. 1 lines 42-50) **which utilizes packets for sending data** (packet example shown in Fig. 13).

It would have been known obvious to one of ordinary skill in the art to use the IEEE 1394 standard as the interface of Mori. The motivations for doing so include the facts that IEEE 1394 is fast, smart, and an industry standard. Because it is an industry standard, it would be advantageous for an inventor to include its functionality in order for the invention to communicate with other devices on the market. Further, since it is an industry standard, it is well adopted by large companies and would have been well known to those of ordinary skill in the art.

Regarding claim 2, the apparatus elements of Mori in view of Fukunaga as combined as obvious in the rejection of claim 1 perform all of the method steps of method claim 2. Thus, claim 2 is rejected for the same reasons as stated in the rejection of claim 1 above.

Regarding claim 4, Mori teaches **a printing device** (printer 1500 shown physically in Fig. 1 and functionally in Fig. 2) **comprising:**

input means (input section 18, which accepts print data and printer control information from the host computer) **to which image data and print control information including information the number of pages on one page of a print sheet** (F11 in Fig. 9 shows a clear

example of information indicating the number of print images on one page; col. 9 lines 38-52,

wherein N is the number of print images on one page) **and information indicating the**

inclusion of a blank image in the image to be printed on the print sheet (Fig. 8 step 3, Fig. 10

spaces SP11, SP12, SP13, SP14, Fig. 11, Fig. 13; col. 1 lines 56-57 and throughout – in the

invention of Mori, a user can select to include blank pages along with image pages in order to

allow for notes to be taken, this blank page can be completely blank or have blank spaces in it as

shown in Fig. 11, this blank page information then must be sent along with the rest of the print

job to be printed on the sheet [examples shown in Fig. 10 and 12]) **are inputted; and**

printing means for printing an image represented by the image data inputted to the

input means in accordance with the print control information (printer engine 17 performs the

actual printing in accordance with print information; col. 5 lines 61-62);

the printing means setting an image area to be printed on the print sheet as a blank

area in the case where the print control information including information indicating

inclusion of a blank page is inputted (print sheet including blank page is shown in Figs. 6, 10,

and 12 in the cases where blank page information is inputted) <u>in a position of associated block</u>

<u>information</u> (e.g. Fig. 10, wherein a blank image is printed in the position of block SP14) <u>not</u>

<u>present in a desired result</u> (the block information, whatever internal code designating the block

[e.g. parameters, positions, for printing discussed in col. 8 lines 60-64], is not printed in the

desired result shown in Fig. 10).

While Mori teaches the sending of data to and from a printer in Fig. 2 through a

predetermined communication medium [col. 1 line 12] bi-directional [col. 5 line 17] interface 21,

Mori does not specifically teach that this interface be **the IEEE (the Institute of Electrical and Electronics Engineers) 1394 standard which utilizes packets for sending data.**

Fukunaga teaches interfacing between a computer and a printer via **the IEEE 1394 standard** (Fig. 1A; col. 1 lines 42-50) **which utilizes packets for sending data** (packet example shown in Fig. 13).

It would have been known obvious to one of ordinary skill in the art to use the IEEE 1394 standard as the interface of Mori. The motivations for doing so include the facts that IEEE 1394 is fast, smart, and an industry standard. Because it is an industry standard, it would be advantageous for an inventor to include its functionality in order for the invention to communicate with other devices on the market. Further, since it is an industry standard, it is well adopted by large companies and would have been well known to those of ordinary skill in the art.

Regarding claim 5, the apparatus elements of Mori in view of Fukunaga as combined as obvious in the rejection of claim 4 perform all of the method steps of method claim 5. Thus, claim 5 is rejected for the same reasons as stated in the rejection of claim 4 above.

Regarding claim 7, Mori teaches **an image printing system** (Fig. 2) **comprising:**

an image processing device (host computer 300 as shown functionally in Figs. 2 and 3) **including**

image processing means (CPU 1; col. 4 lines 51-53) **for performing image processing on an image signal inputted from outside** (image data can be inputted from external memory 11 for print preparation) **and thus generating image data** (graphic engine 202 as shown in Fig.

3 is controlled by the CPU and takes an image signal and rasterizes it into image data for printing

and then sends the data to the printer driver 203; col. 4 line 54 and col. 6 lines 42-44);

control information generation means (printer driver 203; col. 6 lines 25-27) **for**

generating control information (control commands for the printer discussed in col. 6 lines 48-

51) **including information indicating the number of print images on one page of a print**

sheet (F11 in Fig. 9 shows a clear example of information indicating the number of print images

on one page; col. 9 lines 38-52, wherein N is the number of print images on one page); **and**

output means (system spooler 204 as shown in Fig. 3 outputs image data and control

information to the printer for controlling the printing of the printer, wherein the actual physical

device sending the data over the interface 21 is the printer controller 8) **for including the image**

data generated by the image processing means and the print control information generated

by the control information generation means and outputting to a printing device (outputting

data to the printer; col. 1 lines 55-56);

the control information generation means generating print control information

including information which includes a blank image in the image to be printed on the print

sheet (Fig. 8 step 3, Fig. 10 spaces SP11, SP12, SP13, SP14, Fig. 11, Fig. 13; col. 1 lines 56-57

and throughout – in the invention of Mori, a user can select to include blank pages along with

image pages in order to allow for notes to be taken, this blank page can be completely blank or

have blank spaces in it as shown in Fig. 11, this blank page information then must be sent along

with the rest of the print job to be printed on the sheet [examples shown in Fig. 10 and 12]) **in a**

position of associated block information (e.g. Fig. 10, wherein a blank image is printed in the

position of block SP14) **not present in a desired result** (the block information, whatever

internal code designating the block [e.g. parameters, positions, for printing discussed in col. 8

lines 60-64], is not printed in the desired result shown in Fig. 10); **and**

a printing device (printer 1500 shown physically in Fig. 1 and functionally in Fig. 2)

including

input means (input section 18, which accepts print data and printer control information

from the host computer) **to which image data and print control information including**

information the number of pages on one page of a print sheet (F11 in Fig. 9 shows a clear

example of information indicating the number of print images on one page; col. 9 lines 38-52,

wherein N is the number of print images on one page) **and information indicating the**

inclusion of a blank image in the image to be printed on the print sheet (Fig. 8 step 3, Fig. 10

spaces SP11, SP12, SP13, SP14, Fig. 11, Fig. 13; col. 1 lines 56-57 and throughout – in the

invention of Mori, a user can select to include blank pages along with image pages in order to

allow for notes to be taken, this blank page can be completely blank or have blank spaces in it as

shown in Fig. 11, this blank page information then must be sent along with the rest of the print

job to be printed on the sheet [examples shown in Fig. 10 and 12]) **are inputted; and**

printing means for printing an image represented by the image data inputted to the

input means in accordance with the print control information (printer engine 17 performs the

actual printing in accordance with print information; col. 5 lines 61-62);

the printing means setting an image area to be printed on the print sheet as a blank

area in the case where the print control information including information indicating

inclusion of a blank page is inputted (print sheet including blank page is shown in Figs. 6, 10,

and 12 in the cases where blank page information is inputted).

While Mori teaches the sending of data to and from a printer in Fig. 2 through a

predetermined communication medium [col. 1 line 12] bi-directional [col. 5 line 17] interface 21,

Mori does not specifically teach that this interface be **the IEEE (the Institute of Electrical and**

Electronics Engineers) 1394 standard which utilizes packets for sending data.

Fukunaga teaches interfacing between a computer and a printer via **the IEEE 1394**

standard (Fig. 1A; col. 1 lines 42-50) **which utilizes packets for sending data** (packet example

shown in Fig. 13).

It would have been known obvious to one of ordinary skill in the art to use the IEEE 1394

standard as the interface of Mori. The motivations for doing so include the facts that IEEE 1394

is fast, smart, and an industry standard. Because it is an industry standard, it would be

advantageous for an inventor to include its functionality in order for the invention to

communicate with other devices on the market. Further, since it is an industry standard, it is well

adopted by large companies and would have been well known to those of ordinary skill in the art.

Regarding claim 8, the apparatus elements of Mori in view of Fukunaga as combined as

obvious in the rejection of claim 7 perform all of the method steps of method claim 8. Thus,

claim 8 is rejected for the same reasons as stated in the rejection of claim 7 above.

Regarding claim 9, the apparatus elements of Mori in view of Fukunaga as combined as

obvious in the rejection of claim 1 perform all of the program steps of recording medium having

a program stored therein claim 9. Further, Mori teaches in col. 1 lines 13-15 and 61-62 that the

invention provides for a storage medium for storing a computer readable program to perform the

data processing methods of Mori. Therefore, claim 9 is rejected for the reasons stated in the rejection of claim 1 as implemented as a program.

Regarding claim 10, the apparatus elements of Mori in view of Fukunaga as combined as obvious in the rejection of claim 4 perform all of the program steps of recording medium having a program stored therein claim 10. Further, Mori teaches in col. 1 lines 13-15 and 61-62 that the invention provides for a storage medium for storing a computer readable program to perform the data processing methods of Mori. Therefore, claim 10 is rejected for the reasons stated in the rejection of claim 4 as implemented as a program.

Allowable Subject Matter

8.   Claims 3 and 6 are allowed.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Relph (US 6092171) teaches a system and method for using a memory management unit to reduce memory requirements including setting a memory address to 0 when there is a blank page and Nishikawa et al. (US 20050052662) teaches a printing control method and apparatus, see specifically figures 5, 18, 21, and 24 and their corresponding descriptions.

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The

examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KING Y. POON
PRIMARY EXAMINER

Lucas Divine
Examiner
Art Unit 2624